

Remarks

Claims 21-32 will be pending upon entry of this amendment.

Claims 1-20 have been canceled without prejudice. New claims 21-32 add new embodiments to the provisionally elected group (see below) of the claimed invention. New claims 21-32 find support throughout the specification as originally filed. Specifically, support for claims 21-27 and 31-32 is found *inter alia* at page 11, lines 21-25; page 20, lines 22-23; original SEQ ID NO:2; page 12, line 34 to page 13, line 2. Support for claims 28-30 can be found *inter alia* at page 12, lines 15-17; page 13, lines 27-30; page 26, lines 29-30; and at page 20, lines 14-23. Thus, no new matter has been added by way of amendment.

The amendment to the specification is to add reference to the ATCC deposit number. No new matter is introduced by this amendment.

The Restriction Requirement

The Examiner has required an election under 35 U.S.C. § 121 of one of the following groups: Group I, claims 1-7, drawn to isolated polynucleotides, vectors, host cells, and methods of use; Group II, claims 8 and 9, drawn to polypeptides; Group III, claim 10, drawn to antibodies; Group IV, claim 11 and 13, drawn to agonists and methods of use; Group V, claims 12 and 14, drawn to antagonists and methods of use; Group VI, claim 15, drawn to methods of gene therapy by administering a DNA encoding an agonist; Group VII, claim 16, drawn to methods of gene therapy by administering a DNA encoding an antagonist; Group VIII, claims 17 and 18, drawn to methods of identifying compounds; Group IX, claim 19, drawn to methods of diagnosis by identifying mutations; and Group X, claim 20, drawn to methods of diagnosis by analyzing the presence of polypeptide. (*See*, Paper No. 7 at pages 2-3). The Examiner contends that the inventions are distinct, each

from the other.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of group II, corresponding to original claims 8 and 9, drawn to polypeptides. Applicants point out that original claims 8 and 9 have been canceled and that new claims 21-32 are directed to subject matter falling within the ambit of group II. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. In such case, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the restriction requirement. As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

See, M.P.E.P. § 803 at 800-[3-4]. Thus, even assuming, *arguendo*, that the ten (10) groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of multiple groups would entail a “serious burden.” *Id.* In the present situation, no such showing has been made.

Thus, in view of M.P.E.P. § 803, the claims of all of groups I - X should be searched and examined in the subject application. Applicants submit that a search of the subject matter of group 1 would provide useful information for the subject matter of the other groups. Indeed, since the different groups are directed to related sequences (SEQ ID NOs:1 and 2), a search of each of the groups would largely, if not entirely, overlap. Thus, since the

searches for the polynucleotides of group I, polypeptides of group II, antibodies of group III, agonists of group IV, antagonists of group V, methods of treatment of groups VI and VII, the methods of identifying compounds of group VIII, the methods of diagnosis by identifying mutations of group IX, and the methods of diagnosis by analyzing the presence of polypeptide of group X would overlap, the search and examination of all these groups would not entail a serious burden. Accordingly, Applicants respectfully request that the Restriction Requirement Under 35 U.S.C. § 121 be withdrawn and the instant claims be examined in one application.

Objection to the Specification Under 37 C.F.R. 1.821(d)

The specification was objected to as lacking reference to one or more unspecified sequence identifiers in either the specification or the claims. The claims and specification as amended are believed to possess all required sequence identifiers. Thus, withdrawal of this objection is respectfully requested.

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application.

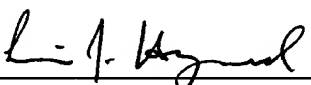
Conclusion

In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance. An early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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